THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JIANGBO OUYANG, PHILIP D. DECK
and WILLIAM L. HARPEL

Appeal No. 96-3906
Application No. 08/038,588[1]

ON BRIEF

Before WINTERS, GRON and WEIMAR, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

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[1] Application for patent filed March 26, 1993.

This appeal was taken from the examiner's decision rejecting claims 1, 2 and 4 through 6. Claims 8 through 13, which are the only other claims remaining in the application, stand withdrawn from further consideration by the examiner as directed to a non-elected invention.

Claim 1, which is illustrative of the subject matter on appeal, reads as follows:

1. A method for preparing metal surfaces for the application of paint and siccative coatings thereto comprising adding an effective amount to said metal surfaces of an aqueous solution of citric acid, a hydroxycarboxylic acid salt, a nonionic surfactant having an HLB of about 3 to about 8 and sodium xylene sulfonate.

The references relied on by the examiner are:

Austin	3,879,216	Apr. 22, 1975
Holder et al. (Holder)	4,789,406	Dec. 6, 1988
King et al. (King)	4,599,116	July 8, 1986
VanEenam	5,080,831	Jan. 14, 1992

Claims 1, 2 and 4 through 6 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Claims 1, 2 and 4 through 6 also stand rejected as based on a specification which does not comply with the description and enablement requirements of 35 U.S.C. § 112, first paragraph. Finally, claims 1, 2 and 4 through 6 stand rejected under

35 U.S.C. § 103 as unpatentable over the combined disclosures of Austin, Holder, King and VanEenam.

DISCUSSION

Initially, we note that applicants proffered an amendment after Final Rejection on August 17, 1995 (Paper No. 12). The examiner denied entry of that amendment in the Advisory Action mailed August 30, 1995 (Paper No. 13). Therefore, the examiner's reference to claim language "now claimed in the amendment after final" makes little sense (Examiner's Answer, page 8, lines 1 and 2). A correct copy of claim 1 on appeal is reproduced supra.

Respecting the rejection of claims 1, 2 and 4 through 6 under 35 U.S.C. § 112, second paragraph, the examiner states that reciting "an effective amount" in claim 1 is indefinite because "the claim fails to state the function which is to be achieved by using said an effective amount" (Examiner's Answer, page 3, third paragraph). This rejection is manifestly untenable. Pending claims in a patent application are read, not in a vacuum, but rather in light of the supporting specification. See In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Here, it is abundantly clear from the specification that "an effective amount" refers to an amount of the aqueous solution effective to clean the

metal surface and prepare same for painting. For example, see the specification, page 2, lines 20 through 24; and

page 8, lines 1 through 5. It is the examiner's burden, in setting forth a rejection under 35 U.S.C. § 112, second paragraph, to explain why the specification does not conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which appellants regard as their invention. The examiner has not satisfied that burden here. This rejection is reversed.

Again, in setting forth the rejection of claims 1, 2 and 4 through 6 under 35 U.S.C. § 112, first paragraph, the examiner has the burden of establishing that the original specification does not provide written descriptive support for the invention now claimed and that the claims are based on a non-enabling disclosure. Again, the examiner has not satisfied that burden. With respect to written descriptive support, the examiner argues that the original specification does not support the recitation "preparing metal surfaces for the application of paint" (Examiner's Answer, paragraph bridging pages 3 and 4). The argument lacks merit. The entire thrust of the original specification relates to cleaning metal surfaces and preparing same for the application of paint, using appellants' aqueous cleaning solution. With

respect to enablement, the examiner does not explain why he doubts the truth or accuracy of any statement in the supporting disclosure. Nor does the examiner back up assertions of his own with acceptable evidence or reasoning inconsistent with the contested statement. Therefore, the examiner has not established a prima facie case of lack of enablement. In re Armbruster, 512 F.2d 676, 677, 185 USPQ 152, 153 (CCPA 1975). This rejection is reversed.

In rejecting claims 1, 2 and 4 through 6 under 35 U.S.C. § 103, the examiner begins with Austin's disclosure of an oxide remover solution and the application of that solution to a metal surface to be cleaned. According to the examiner, the oxide remover solution is an aqueous acidic solution preferably containing citric acid and a nonionic surfactant. As stated by the examiner, the difference between Austin's method and the claimed method is that Austin does not disclose a hydroxy-carboxylic acid salt (e.g., sodium citrate) or sodium xylene sulfonate in the oxide remover solution. Nor does Austin disclose a nonionic surfactant "having an HLB of about 3 to

about 8."[2]

According to the examiner, it would have been obvious to modify Austin's oxide remover solution by adding (1) sodium citrate, per the teachings of Holder and King; and (2) sodium xylene sulfonate, per the teachings of VanEenam (Examiner's Answer, paragraph bridging pages 6 and 7). Further, the examiner says, it would have been obvious to adjust the HLB of Austin's nonionic surfactant in the range of about 3 to about 8 "to obtain optimum results" (Examiner's Answer, page 7, first full paragraph). The examiner argues that a person having ordinary
skill in the art, by modifying Austin's method in this way, would have arrived at the instantly claimed method. The argument lacks merit. Certainly, the prior art could be modified in the manner proposed by the examiner. This can be seen from a review of appellants' specification and claims. However, merely because the prior art could be so modified

[2] Nonionic surfactants are often characterized in terms of their HLB (hydrophile-lipophile balance) number. See Kirk-Othmer, 22 Encyclopedia of Chemical Technology 360-62 (3d ed., John Wiley & Sons, Inc. 1983) (copy enclosed with this opinion).

would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Here, the examiner does not point to any portion or portions of the cited references establishing how or why the prior art "suggested the desirability of the [proposed] modification." In re Gordon, 733 F.2d at 902, 221 USPQ at 1127.

We also invite attention to King's disclosure suggesting that the HLB number of the surfactant, or at least one of the combination of surfactants disclosed by King, is preferably controlled within at least about 12 up to about 15, and especially from about 13 to about 15 (King, column 4, line 62 through column 5, line 41). This being the case, it would appear that King tends to teach away from, not toward, the claimed
invention which requires a nonionic surfactant "having an HLB of about 3 to about 8."[3]

[3] On return of this application to the Examining Corps, the examiner should ensure that dependent claim 6 is canceled. Claim 6 reiterates the limitation appearing in claim 1 that the nonionic surfactant has an HLB from about 3 to about 8.

According to the examiner, it would have been obvious to modify Austin's method, per the teachings of Holder, King, and VanEenam, "because all references are from the same technical endeavor" (Examiner's Answer, page 7, line 1). That, however, is not sufficient reason or justification to support the rejection under 35 U.S.C. § 103. It does not follow, merely because all references are from the same field of endeavor, that the cited

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Claim 6, therefore, does not "specify a further limitation of the subject matter claimed." 35 U.S.C. § 112, fourth paragraph.

prior art suggests the desirability of the proposed modification of Austin's method.

The Patent and Trademark Office has the burden under 35 U.S.C. § 103 to establish a prima facie case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The examiner has not satisfied that burden here. On this record, the examiner has not established that there is adequate suggestion or incentive stemming from the prior art which would have led a person having ordinary skill to combine the references in the manner proposed. Rather, the examiner has engaged in a hindsight reconstruction of the claimed invention, using appellants' disclosure as a template and selecting elements from references to fill the gaps. In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). The rejection under 35 U.S.C. § 103 is reversed.

For the reasons set forth in the body of this opinion, we do not sustain the rejections under 35 U.S.C. § 112, first or second paragraphs, or the rejection under 35 U.S.C. § 103.

The examiner's decision is reversed.

REVERSED

SHERMAN D. WINTERS Administrative Patent Judge	)	
TEDDY S. GRON Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
ELIZABETH C. WEIMAR Administrative Patent Judge	)	

clm

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